

REMARKS

In the Office Action, the Examiner rejected claims 1-14, 16-22, and 24-39. By this Response, Applicants amend claims 1-8, 10, 12-14, 16-17, 19-21, 24-27, 30-32, 34-35 and 38-39 and cancel claims 29, 33, and 37. Currently, claims 1-14, 16-22, 24-28, 30-32, 34-36, and 38-39 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and following remarks, Applicants respectfully request allowance of all pending claims.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-4, 21-22, 28, and 31-32 as anticipated by Uehara et al. (U.S. Patent No. 5,659,376, hereinafter the "Uehara" reference). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention "in as complete detail as contained in the ... claim" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Further, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. *See Id.*

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." *See Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on "usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art." *See Id.*

Claim 1 and its Dependent Claims

The Uehara reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "a resilient pad disposed between and adjacent the outer panel and both the support section and the inner display panel," as recited by independent claim 1. (Emphasis added.) In contrast, the Uehara reference teaches an elastic member 161 that is separated from a glass plate 111 by a portion of an upper housing 100C1. *See* Uehara, Fig. 12. It follows that the elastic member 161 is not adjacent the glass plate 111 because a portion of the upper housing 100C1 is interposed between the two. Thus, the Uehara reference could not possibly teach *all* of the features of claim 1. In view of these deficiencies, among others, the cited reference cannot

anticipate claim 1 or the claims that depend therefrom.

The Uehara reference is deficient with respect to claim 1 in other aspects. For instance, the Uehara reference does not teach or suggest "a resilient pad disposed between and adjacent the outer panel and both the support section and the inner display panel," as recited by independent claim 1. (Emphasis added.) In contrast, the Uehara reference teaches that both the upper housing 100C1 and glass plate 111 are on the same side of the elastic member 161. *See id.* Consequently, the elastic member 161 could not possibly be between the glass plate 111 and the upper housing 100C1. Thus, for this reason also, the cited reference cannot anticipate claim 1 or the claims that depend therefrom.

Claim 21 and its Dependent Claims

With respect to claim 21, the Uehara reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "a shock absorbent pad disposed between the protective outer surface of the display and the housing," as recited by independent claim 21. (Emphasis added.) In contrast, the Uehara reference teaches an elastic member 161 disposed between an upper housing 100C1 and an LCD 111. *See id.* The elastic member 161 is not between the glass plate 111 and the upper housing 100C1. *See id.* Thus, the Uehara reference could not possibly teach *all* of the features of claim 21. In view of these deficiencies, among others, the cited reference cannot anticipate claim 21 or the claims that depend therefrom.

Moreover, the cited reference does not teach or suggest a "shock absorbent pad [that] comprises a face with an adhesive region and a non-adhesive region," as recited by independent claim 21. (Emphasis added.) In contrast, the Uehara reference merely discloses an elastic member 161 without mentioning an adhesive region, let alone a face with an adhesive region and a non-adhesive region. *See id* at col. 10, ll. 55-62. Thus, the Uehara reference could not possibly teach *all* of the features of claim 21. For this reason also, the cited reference cannot anticipate claim 21 or the claims that depend therefrom.

For these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-6, 8-14, 16-22, 24-30, 34-36, and 38 as obvious over Ohgami et al. (U.S. Patent No. 5,574,625, hereinafter the "Ohgami" reference) in view of Anderson et al. (U.S. Patent Application No. 2002/0149714, hereinafter the "Anderson" reference). The Examiner also rejected claims 1-14, 16-22, 24-30, 34-36, and 38 as obvious over Yang et al. (U.S. Patent No. 6,781,819, hereinafter the "Yang" reference) in view of the Ohgami reference and the Anderson reference. Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002).

Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

First Rejection

In the Office Action, the Examiner rejected claims 1-6, 8-14, 16-22, 24-30, 34-36, and 38 as obvious over the Ohgami reference in view of the Anderson reference. Applicants respectfully traverse this rejection.

Claim 1

The rejection based on the Ohgami reference and the Anderson reference is deficient for a number of reasons. For instance, the cited references do not teach or suggest, alone or in hypothetical combination, "a resilient pad disposed between and adjacent the outer panel and both the support section and the inner display panel," as recited by independent claim 1. (Emphasis added.)

'In sharp contrast, the Ohgami reference teaches double-sided tape 62 disposed between an acrylic panel 18 and a flange 61 of an upper case 11. *See* Ohgami, Fig. 8. The double-sided tape 62 is not adjacent the LCD display panel 64. *See id.* Thus, the Ohgami reference does not teach or suggest all of the features of claim 1.

Moreover, the secondary reference also fails to disclose or suggest these features. The Anderson reference discloses a display with two instances of double-sided foam tape, neither of which has the features of the resilient pad recited by claim 1. The Anderson reference teaches a double-sided foam tape 210 disposed between a frame 215 and an

LCD 205 and a different double-sided foam tape disposed between the frame 215 and a protective panel 255. *See* Anderson, Figs. 2A and 2B. Neither instance of double-sided foam tape is adjacent the protective panel 255 *and* the LCD panel 205. *See id.* Thus, the Anderson reference also fails to teach or suggest this feature of claim 1.

In view of these deficiencies, among others, the Ohgami reference and the Anderson reference, taken alone or in hypothetical combination, cannot render obvious claim 1 or the claims that depend therefrom.

Claim 10

Here again, the rejection based on the Ohgami reference and the Anderson reference is deficient for a number of reasons. For example, the cited references do not teach or suggest, alone or in hypothetical combination, a "shock absorbent pad [that] comprises a double-sided adhesive region and a single-sided adhesive region," as recited by independent claim 10. (Emphasis added.) In sharp contrast, the Ohgami reference teaches double-sided tape 62 and the Anderson reference discloses double-sided foam tape 210. Neither reference indicates that the tape 62 or 210 would or could include a single-sided adhesive region. Indeed, the Examiner stated that the cited references do not teach that "the shock absorbent pad comprises a double-sided adhesive region and a single-sided adhesive region." Office Action, pg. 5.

After noting this deficiency, the Examiner then asserted that "[i]t would have been obvious to one having ordinary skill in the art at the time [the] invention was made to employ an absorbent pad comprising a double-sided adhesive region and a single-sided adhesive region, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184." Office Action, pg. 5.

Applicants respectfully disagree. The Examiner has improperly cited *In re Karlson* for the proposition that “omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art.” The C.C.P.A has explicitly stated that *In re Karlson* does not support the proposition for which it was cited by the Examiner. *See e.g. In re Wright*, 145 U.S.P.Q. 182, 190 (C.C.P.A. 1965). In the *In re Wright* case, the court stated that:

this finding is based upon a determination of obviousness under section 103 and not upon a mechanical rule, which the solicitor would have us extract from *In re Karlson* ... about the omission of an element and its function from a known combination being obvious if the remaining elements perform the same function as before. Language to this effect in *Karlson* was never intended to short-circuit the clear wording of 35 U.S.C 103.

See id.

Thus, the rational provided by the Examiner for the obviousness of the proposed modification is *not* supported by the cited case.

Further, Applicants note that the Examiner has not provided *any* evidence to support the proposed modification under *applicable* case law. As summarized above, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Here, the Examiner has failed to provide *any* reason to modify the teachings of the cited references, let alone provide objective evidence to support such a rational. In fact, the cited references clearly do not suggest the desirability of the proposed modification. Thus, the Examiner has proposed modifying the devices taught by the Ohgami reference and the Anderson reference in a manner that would not be obvious to one of ordinary skill in the art.

In view of these deficiencies, among others, the Ohgami reference and the Anderson reference, taken alone or in hypothetical combination, cannot render obvious claim 10 or the claims that depend therefrom.

Claim 16

Here again, the rejection based on the Ohgami reference and the Anderson reference is deficient for a number of reasons. For example, the cited references do not teach or suggest, alone or in hypothetical combination, a "shock absorbing pad [that] comprises a non-adhesive portion disposed against an electronic display panel of the display panel," as recited by independent claim 16. (Emphasis added.) To the contrary, as noted above, the Ohgami reference teaches double-sided tape 62, and the Anderson reference discloses double-sided foam tape 210. Neither reference discloses or suggests a shock absorbing pad that has a non-adhesive portion, let alone such a shock absorbing pad with the non-adhesive portion disposed against an electronic display panel. In view of these deficiencies, among others, the Ohgami reference and the Anderson reference, taken alone or in hypothetical combination, cannot render obvious claim 16 or the claims that depend therefrom.

Claim 21

With respect to claim 21, the rejection based on the Ohgami reference and the Anderson reference is deficient for a number of reasons. For example, the cited references do not teach or suggest, alone or in hypothetical combination, a "shock absorbent pad [that] comprises a face with an adhesive region and a non-adhesive region," as recited by independent claim 21. (Emphasis added.) Conversely, both the Ohgami reference and the Anderson reference teaches double-sided tape 62 or foam 210, as noted above, and neither reference teaches that the tape 62 or foam 210 has a non-adhesive region. Moreover, the Examiner has failed to support the extensive modifications associated with adding such a feature to the devices taught by the Ohgami reference and the Anderson reference. In view of these deficiencies, among others, the

Ohgami reference and the Anderson reference, taken alone or in hypothetical combination, cannot render obvious claim 21 or the claims that depend therefrom.

For these reasons, among others, Applicants respectfully request withdrawal of the present rejection under 35 U.S.C. § 103.

Second Rejection

In the Office Action, the Examiner rejected claims 1-14, 16-22, 24-30, 34-36, and 38 as obvious over the Yang reference in view of the Ohgami reference and the Anderson reference. Applicants respectfully traverse this rejection.

Previously, Applicants submitted a Declaration under 37 C.F.R. § 1.131 to remove the Yang reference with the Amendment and Response filed on April 7, 2006. In the present Office Action, the Examiner stated that “[t]he evidence submitted is insufficient to establish applicant’s alleged actual reduction to practice of the invention in this country of a NAFTA or WTO member country after the effective date of the Yang et al. reference. Exhibits A, B and C are missing.” Accordingly, with this Response, Applicants are re-submitting the Declaration and Exhibits previously submitted and re-iterating the request for removal of the Yang reference.

Removal of the Yang Reference pursuant to 37 C.F.R. § 1.131

The Yang reference is allegedly prior art under 35 U.S.C. § 102(e). Pursuant to 37 C.F.R. § 1.131, the Applicants may remove alleged prior art under Section 102(e) from consideration by filing an appropriate declaration that establishes the invention of the claimed subject matter in the United States, a NAFTA country, or a WTO member country prior to the effective filing date of a cited reference. Prior invention may be shown by demonstrating reduction to practice of the claimed subject matter in the United States, a NAFTA country, or a WTO member country prior to the effective filing date of the cited reference. Here, the Applicants have attached a declaration signed by Steven

Homer, an inventor of record, to demonstrate that the invention disclosed and claimed in the present application was conceived and actually reduced to practice in the United States prior to the December 17, 2002, filing date of the Yang reference. *See* M.P.E.P. §§ 715 and 2136.03.

Specifically, in paragraph 3 of the attached Rule 131 Declaration, Steven Homer declares that the subject matter disclosed and claimed in the present application was conceived in the United States prior to December 17, 2002. *See* Rule 131 Declaration of Steven Homer (hereafter referred to the “Declaration”), paragraph 3. In support of the Declaration, Exhibit A includes a redacted and labeled sketch that depicts an embodiment of the claimed subject matter. *See* Exhibit A. Therefore, Applicants submit that Exhibit A and the Declaration are sufficient to demonstrate conception of the claimed subject matter in the United States prior to the December 17, 2002, filing date of the Yang reference.

Further, the Applicants’ date of reduction to practice is amply supported by the Declaration and drawings prepared prior to December 17, 2002. *See* Exhibits B and C and Declaration, paragraph 4. As set forth in the Declaration, an inventor of record, Steven Homer, declares that the drawings identified as Exhibits B and C document the successful construction of a working prototype. *See* Exhibits B and C and Declaration, paragraph 4. Specifically, Exhibits B and C illustrate a tablet computer housing 10 having a top opening with a perimeter edge 12, a controller 14 disposed within the housing 10, and a display assembly or panel 16 disposed in the opening with the perimeter edge 12. *See id.* The display assembly or panel 16 has a top surface 18 that extends to the perimeter edge 12. *See id.* In this illustrated example, the top surface 18 and the perimeter edge 12 form a smooth and uninterrupted surface. *See id.* Further, a pad 20 is located between the housing 10 and the display assembly or panel 16. *See id.* The pad 20 is configured to absorb shock between the housing 10 and the display assembly or panel 16. Thus, attached Exhibits B

and C and the Declaration demonstrate a date of actual reduction to practice in the United States prior to the December 17, 2002, filing date of the Yang reference.

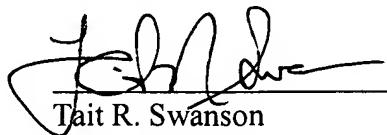
In summary, Applicants submit that Exhibits A, B, and C and the Declaration are sufficient to demonstrate conception and subsequent actual reduction to practice of the claimed subject matter in the United States before the apparent effective date of December 17, 2002 of the Yang reference. In view of the evidence discussed above, Applicants respectfully request removal of the Yang reference and withdrawal of the related rejection under 35 U.S.C. § 102.

For these reasons, among others, Applicants respectfully request withdrawal of all rejections with respect to the Yang reference.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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